

89-149 (1)

FILED
JUL 24 1989

No.

IN THE
Supreme Court of the United States
OCTOBER TERM, 1989

EVERPURE, INC.

Petitioner,

vs.

CUNO, INC.

Respondent.

**PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

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QUESTIONS PRESENTED

Whether the United States Court of Appeals for the Federal Circuit, (hereinafter "Federal Circuit") in an issue of first impression, misapplied the doctrine of repair/reconstruction and the provisions of 35 U.S.C. §271(c) as interpreted by this Court in *Aro Manufacturing Co., Inc. v. Convertible Top Replacement Co., Inc.*, 365 U.S. 336, (1961), and 377 U.S. 476, (1964) [hereinafter *Aro I* and *II*, respectively] in holding that where a party (the defendant/respondent here) supplies incompatible replacement filter cartridges for use in a patented filter assembly sold by plaintiff/petitioner to its customers, and also supplies an adapter which not only enables the use of such normally incompatible filter cartridges in the assembly, but further includes additional structural features of the assembly *which do not need replacement and incorporate a material part of the invention*, that party is not a contributory infringer?

a) Whether the Federal Circuit circumvented the intent of Congress in drafting §271(c), as reported by this court in *Aro I* and *Aro II*, *i.e.*, to preserve the previously existing judge-made law of contributory infringement, by, in effect granting the original purchaser overly broad leeway in repairing a patented device when the replaced component is attached to a material part of the invention?

b) Whether, in the Federal Circuit decision, the well reasoned dissenting opinion of Judge Newman is more consistent with the decisions of this Court than is the majority opinion written by Judge Markey which, if left standing, will make it possible for competitors who deliberately copy patented inventions to avoid liability for infringement?

c) Whether the Federal Circuit abused its discretion in affirming a District Court's grant of summary judgment based on a preliminary injunction hearing, when all factual issues had not yet been resolved, such as whether the defendant could have provided a cartridge and/or an adapter which did not incorporate a material part of the patented invention, but yet was still compatible with plaintiff's assembly?

PARTIES

The parties named in the caption are the only parties to this action.

Pursuant to Supreme Court Rule 28.1, petitioner Everpure, Inc. is a Nevada corporation located at 660 North Blackhawk Drive, Westmont, Illinois, 60559. Everpure, Inc. is a wholly-owned subsidiary of Culligan International Company. Everpure, Inc. has no publicly held affiliates.

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United States Patent
No. 3,746,171

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Petitioner respectfully prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit [hereinafter "Federal Circuit"] in its cause Nos. 88-1612, -1613. The judgment was made and entered on May 17, 1989. Neither party requested rehearing.

OPINIONS BELOW

The opinion of the Federal Circuit has been reported at 875 F.2d 300 and is reprinted in the Appendix to this Petition commencing at page A1. The District Court's opinion is reported at 705 F.Supp. 725 and is reprinted in the Appendix to this Petition commencing at page A13.

JURISDICTION

The judgment of the Federal Circuit was made and entered in this action on May 17, 1989. This Court has jurisdiction by virtue of 28 U.S.C. §1254(1).

THE CONSTITUTIONAL PROVISIONS, STATUTES AND RULES INVOLVED

U.S. Constitution, Article I, Section 8, Clause 8

The Congress shall have the power . . . to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

35 U.S.C. §154

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, subject to the payment of fees as provided for in this title, of the right to exclude others from making, using or selling the invention throughout the United States, . . . referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

35 U.S.C. §271(a)

Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

35 U.S.C. §271(b)

Whoever actively induces infringement of a patent shall be liable as an infringer.

35 U.S.C. §271(c)

Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for noninfringing use, shall be liable as a contributory infringer.

STATEMENT OF THE CASE

Introduction

This case involves an issue of acknowledged first impression regarding the proper interpretation of 35 U.S.C. §271(c) relating to contributory patent infringement, in view of the judge-made doctrine of repair/reconstruction last addressed by this Court in *Aro Manufacturing Co., Inc. v. Convertible Top Replacement Co., Inc.*, 365 U.S. 336 (1961) and 377 U.S. 476 (1964) [hereinafter *Aro I* and *II*, respectively]. In the decision from which the Petitioner seeks a Writ of Certiorari, the Federal Circuit, in a majority opinion by Chief Judge Markey, misapplied the criteria for resolving issues of contributory infringement and repair/reconstruction as set forth by this Court in the *Aro I* and *II* cases.

Specifically, the Federal Circuit held that, in a patented filter assembly for use in obtaining filtered drinking water

for several types of end users, including soda fountains, vending machines and the like, including a fixed filter head, and a replaceable cartridge containing a filter element and having a closure portion specifically designed to lock into the filter head in a specified manner to achieve certain advantages of the invention, the provision by the defendant of an *adapter* which not only enables purchasers of the original patented device to replace worn filter elements, but also reproduces the patented features which provide the patented closure with those advantages, was permissible under the doctrine of repair/reconstruction. If left standing, the majority opinion will provide a way in which a deliberate copier of a patented invention who competes directly with the patentee can avoid liability for infringement, and thus get a "free ride". Furthermore, manufacturers in industries related to filter cartridge or connector technology will, in view of the free ride by some, be discouraged from investing in new products. Ultimately, the consumer will be deprived of technological advances.

In reaching its holding, the majority opinion did not consider the application of 35 U.S.C. §271(c), and failed to correlate the statute with the doctrine of repair/reconstruction. In a strong and well-reasoned dissenting opinion, Judge Newman stated that:

"There is no automatic right to replace unworn, unbroken parts of a patented structure simply because the unworn part is sold or used in attachment to a worn part. While there is no bright line between permissible repair and impermissible reconstruction, in this case the 'adapter' is plainly in the category of reconstruction."

Everpure, Inc. v. Cuno, Inc., No. 88-1612, -1613, slip op. dissent at 4 (Fed. Cir. May 17, 1989) (reprinted in the Appendix at page A10).

The District Court Case

This proceeding was commenced in the United States District Court for the District of Connecticut on a complaint by Everpure, Inc. [hereinafter "Everpure"]. Jurisdiction was vested in the District Court pursuant to the Patent Laws of the United States. The complaint named Cuno, Inc. [hereinafter "Cuno"] as the defendant, and prayed for judgment that Everpure's U.S. Patent No. 3,746,171 [hereinafter "the '171 patent"] was willfully and contributorily infringed by Cuno's sale, use and/or giving away of an adapter identified as "Model FS-A Filter Cartridge Adapter". The Cuno adapter was specially designed for attachment to one of Cuno's own filter cartridges to enable such cartridge to be inserted into and retained by the Everpure filter head as claimed in the '171 patent. The adapter enables the Cuno filter cartridge, which in its conventional form is not compatible with an Everpure filter head, to be effectively inserted into, and used with, the claimed Everpure filter head, and in such a manner as to obtain the advantages of the patented invention.

The filter assembly which is the subject of the '171 patent includes a filter head and mating cartridge, and is commonly used for filtering water for use in commercial beverage machines, such as vending machines or soda fountains installed in fast food restaurants or convenience stores. Filter assemblies of this type include cartridges which are replaced or replenished, depending on the type of cartridge, by a serviceman on an as-needed basis.

Prior to the invention of the '171 patent, in servicing a conventional filter assembly, the serviceman needed to turn off the supply of water to the beverage machine by means of a valve normally located remotely from the machine. The serviceman then opened the pressure vessel

and detached the filter cartridge, usually by employing some type of hand tools. The cartridge was replaced, replenished or recharged as necessary, and was then reconnected to the machine. The remotely located valve would then be turned to the "on" position. The conventional process as described above was time consuming and often resulted in the spillage of water. In addition, it was not uncommon for improperly attached filter cartridges to be forcibly ejected or blown off from the filter assembly due to the high water pressure passed through the filtering system. This forceful ejection of filter cartridges created a safety hazard to the serviceman, as well as to other individuals located in the immediate vicinity.

The Everpure '171 patent provides a convenient and efficient alternative to the prior art devices by the use of a filter head having a rotatable clamping collar and a shut-off valve. The '171 patent also discloses a filter cartridge enclosing a filter element and provided with an upper closure member and ridge formations designed to be engaged by the clamping collar of the head. When the cartridge is inserted into the filter head and the collar rotated, the cartridge closure is placed in communication with the water supply, and the ridge formations are engaged by the collar to prevent the unwanted and hazardous ejection of the cartridge from the head. The manually operated valve is designed to shut off the water during cartridge replacement, and has a formation designed so that when the valve is open, (i.e., in a pressurized position), the formation interacts with the clamping collar to restrain the clamping collar against rotation to an unclamped position.

Everpure manufactures and sells filtration units and replacement cartridge filters. Although in its commercial embodiments, Everpure provides the filter element, the filter

cartridge and the closure member as a unit, the asserted claims of the '171 patent do not specify that these parts be so combined. Accordingly, when using the patented Everpure assembly, the serviceman merely manipulates the valve to shut off the water and to permit rotation of the collar, rotates the collar to release the clamping action, removes the cartridge from the head and replaces it with a new cartridge. The new cartridge is secured to the head by merely reversing the removal procedure. No such cartridge connection and safety/locking means was disclosed or suggested by the prior art.

Subsequent to the establishment of Everpure's filter system in the marketplace, Cuno began the manufacture and sale of its own type of water filters and replacement cartridges. Cuno's cartridges are designed to be used with its own filtration head, and in such form are not compatible with Everpure's head. Cuno achieved only limited success in this market segment. More recently, to gain access to Everpure's replacement cartridge business, Cuno manufactured an adapter which is designed to be attached to Cuno's cartridge. The adapter essentially duplicates the configuration of the Everpure cartridge closure claimed in the '171 patent. The adapter permits one of Cuno's cartridges to be inserted into, and interlocked with, one of Everpure's heads in a manner which employs the clamping collar and attendant formations which provide the safety and anti-blowoff features of the patented invention. The adapter does not have any useful purpose other than to permit Cuno's cartridges to be used in Everpure's filter head. Cuno markets its relatively inexpensive but less effective filters for use in Everpure's filter heads at competitive prices, and supplies the adapter without additional charge to owners of heads supplied by Everpure. Thus, through the use of its adapter, Cuno is stepping into a

market created by Everpure's patented filter assembly and is essentially taking a "free ride" on Everpure's marketing and engineering efforts two years prior to the expiration of the patent.

Everpure asserted claims 1, 4, 5 and 6 of the '171 patent against Cuno. Those claims relate to a filter assembly combination comprising the head, the filter, and a cartridge with special formations on its upper closure member for being releasably locked into the filter head. In addition, the '171 patent includes nonasserted claims addressed separately to the head, as well as to the filter cartridge, *per se*. The existence of these nonasserted claims was pointed out to the District Court.

Responding to the Complaint and to Everpure's Motion for Preliminary Injunction To Preserve The Status Quo, Cuno moved for summary judgment based on the doctrine of permissible repair and argued that an implied license allegedly arose from Everpure's unrestricted sales of patented filter heads. Charges of inequitable conduct before the U.S. Patent and Trademark Office, patent misuse and violations of Rule 11 Federal Rules of Civil Procedure were also made by Cuno. In view of the accelerated hearing schedule for Everpure's Motion for Preliminary Injunction, no formal discovery was taken by either party.

The District Court granted summary judgment, holding that the use of Cuno's separate adapter and filter cartridge in Everpure's patented filter assembly constituted a permissible repair. Although the Court recognized that only the filter element inside the cartridge, and not the entire cartridge unit wears out, and that the '171 patent contemplated that "the cartridge could be reusable with a need then to replace only the filter element" (Appendix, p. A20), the Court ruled that Cuno was not limited under the repair

doctrine to replacement or repair of the worn out filter elements, and that Everpure authorized an implied license to install non-Everpure replacement filter cartridges with an adapter.

The District Court failed to consider the issue of whether Cuno could have merely supplied a replacement cartridge which allowed the replacement of the worn filter element but did not incorporate the patented features of the '171 closure, i.e., the ridges which are engaged by the clamping collar on the head, and prevent unwanted ejection of the cartridge from the head.

This decision permits Cuno to provide purchasers of Everpure's patented assembly with a filter cartridge together with an adapter, as a replacement for an Everpure filter cartridge. The assembly provided by Cuno substitutes Cuno parts for unworn Everpure parts, and changes the structure and operation of the Everpure filtration system, in that the Cuno cartridge without the head is designed to process and filter the water in a different manner than is performed by the Everpure system. As a result, with the assistance of the adapter provided by Cuno, the original purchaser is free to *reconstruct* the patented assembly, even though the original Everpure cartridge head and cartridge closure is not worn out.

As the lower court proceedings never extended beyond the preliminary injunction hearing stage, an issue of fact remains as to whether Cuno could have provided a cartridge which fit into the Everpure heads without employing and incorporating the formations of the closure of the invention which engage the locking mechanisms on the head. Instead, Cuno took great pains to incorporate all features of the Everpure cartridge closure so that all benefits of the patent would be enjoyed by the otherwise

incompatible Cuno cartridge. Cuno even went to the extreme of redesigning the adapter so that the fluid flow of its own cartridge would be reversed and match that of the Everpure filtration system.

The Federal Circuit Appeal

Everpure appealed the District Court's order of summary judgment on grounds substantially similar to those it raised in the District Court. In addition, Everpure argued that the District Court's grant of summary judgment was erroneous in view of 35 U.S.C. §271(a), (b) and (c) and under the doctrine of permissible repair as a result of Cuno's provision of a replacement cartridge and adapter which replaced components of Everpure's patented assembly that were not broken, worn out or spent, and which altered the structure and operation of Everpure's patented assembly. With respect to the doctrine of repair issue, Everpure relied primarily on *Dawson Chemical Company v. Rohm & Haas Co.*, 448 U.S. 176 (1980); *Aro I; King Instrument Corp. v. Otari Corp.*, 814 F.2d 1560 (Fed. Cir. 1987); *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 325 (1909) and *Connecticut Telephone & Electric Co. v. Automotive Equipment Co.*, 14 F.2d 957 (D.N.J. 1926), *aff'd*, 19 F.2d 990 (3rd Cir. 1927), *cert. denied*, 275 U.S. 564 (1927).

On appeal, Cuno argued, *inter alia*, that the District Court's grant of summary judgment was correct in that Cuno's modified cartridge is a one-on-one replacement of Everpure's spent cartridge. Thus, according to Cuno, the doctrine of repair applies, in that the original cartridge was "spent". On this issue, Cuno relied primarily on *Porter v. Farmer's Supply Service, Inc.*, 790 F.2d 882 (Fed. Cir. 1986); *Aro I* and *II*; as well as *Gillette Safety*

Razor Co. v. Standard Safety Razor Co., 64 F.2d 6, (2nd Cir., 1933) cert. denied 290 U.S. 649 (1933).

In affirming the District Court's grant of summary judgment, the Federal Circuit, in the majority opinion by Judge Markey, indicated that because Everpure made the business decision to seal its filter element into the cartridge and to sell disposable cartridges configured so as to render its filter element irreplaceable without replacing the entire cartridge, Everpure's cartridges are subject to replacement by the owners without their incurring liability as direct infringers of Everpure's '171 patent. By taking judicial notice of the configuration of Everpure's cartridge and concluding that the filter element was not replaceable, the Federal Circuit thus improperly shifted the burden to Everpure, the patentee, to establish that repair could be accomplished without infringement. Instead, there was a genuine issue of fact for trial as to whether the cartridge could be repaired (i.e., the filter element replaced) without replacing the patented portion of the filter assembly. The Federal Circuit also relied upon the labels on Everpure's disposable cartridge as promoting disposal of the whole cartridge. The Court ruled that since the Petitioner supplied its cartridges as one-piece units incorporating the relatively short-lived filter element within a relatively long-lived closure member, the entire cartridge is a replaceable part which the initial purchaser is entitled to replace when the filter element is spent.

The Federal Circuit majority opinion concluded that "a buyer commits no direct infringement of claims 1, 4, 5, or 6 when replacing Everpure's spent cartridge with an adapter-cum-cartridge, and, as above-indicated, without direct infringement there can be no contributory or induced infringement." *Everpure, Inc. v. Cuno, Inc.*, No.

88-1612, -1613, slip op. at 7 (Fed. Cir. May 17, 1989) (reprinted in the Appendix at page A6).

The Federal Circuit majority opinion, despite a strongly worded dissent by Judge Newman, thus failed to analyze the following issues:

1. The impact of 35 U.S.C. §271(c) on the doctrine of repair/reconstruction when, in supplying replacement components, the contributory infringer supplies an adapter which replaces nonworn material parts of the invention to effect a reconstruction of the patented combination.
2. If, under the doctrine of repair/reconstruction, Cuno is entitled to provide a replacement filter element to preserve the life of the patented combination, it should not be entitled to provide a filter element in conjunction with an adapter incorporating the specific structural formations which recreate the unique features of the patented combination. These features contained in the adapter are neither worn nor broken and do not require repair.

REASONS FOR GRANTING OF THE WRIT

Introduction

The Federal Circuit opinion in this case should be reviewed on a Writ of Certiorari by this Court because the Federal Circuit's affirmation of the District Court's grant of summary judgment is grounded upon a misapplication of the doctrine of repair/reconstruction as set forth by this Court in *Aro I* and *II*.

Furthermore, in this case of first impression, the Federal Circuit failed to address the significance of the separate Cuno adapter which incorporates material parts of the invention, and as a result, transcends the conventional repair/reconstruction problem as applied to worn or broken parts. The Federal Circuit thus routinely dismissed a significant factor which distinguishes the facts of this case from the precedents in this area upon which the Court based its decision.

A. The Federal Circuit In Its Majority Opinion Failed To Correctly Apply The Doctrine of Repair/Reconstruction as Set Forth by This Court.

In *Wilson v. Simpson*, the leading case in this Court that deals with the doctrine of repair/reconstruction, the Court explained, repair "is not a reconstruction of the invention, but the use *only of so much of it as is absolutely necessary* to identify the machine with what it was in the beginning of its use, or before that part of it had been worn out". *Wilson v. Simpson*, 50 U.S. 109, 125 (1850) (emphasis added). In particular, the repair doctrine draws a distinction between the permissible repair of a worn out or spent part and the impermissible change of an operable

part that is not in need of repair. The doctrine permits the "repair or replacement of any one part of its combination, in connection with the rest of it, not requiring repair." *Wilson v. Simpson, supra*, 50 U.S. at 122. Thus, permissible repair or replacement is "the restoration of *worn out* parts . . . The right of substitution or "resupply" of an element . . . of a patented combination is [the right] to preserve its fitness for use *so as far as it may be effected by wear or breakage*. Beyond this there is *no* license." *Leeds & Catlin, supra*, 213 U.S. at 336 (emphasis added).

Thus, in view of the precedent of this Court in interpreting the doctrine of repair/reconstruction, there is no right under the doctrine of repair to replace unworn, unbroken parts of a patented structure simply because the unworn part is sold or used in attachment to a worn part. In the present case, the adapter supplied by Cuno is plainly in the category of reconstruction, in that it embodies the unworn, material parts of the invention which is claimed in the patent.

A question remains as to whether such reconstruction must be tolerated because it accompanies replacement of the spent or partially spent filter element. This question was not considered by the majority opinion in the Federal Circuit decision. The Federal Circuit majority opinion, as well as the District Court opinion, failed to consider the significance of the fact that the adapter supplied by Cuno is not merely "a configuration to mate it to the head", as characterized by the District Court. *Everpure, Inc. v. Cuno, Inc.*, 705 F. Supp. at 731 (Appendix, page A23). It is not a simple plug, but instead is a material part of the total claimed invention. A purchaser buying the patented Everpure filter system is in fact purchasing the advan-

tages which are set forth in the patent and identified by structural features which are included in the claims.¹

It is also important to note here that a major reason customers of filter assemblies purchase the patented Everpure filter assembly is that the connection of the filter element in the head enabled filter element replacement to be conducted in a more convenient and safe manner. The claims of the '171 patent asserted in the present case relate to the connection of the filter unit into the filter

¹ These include:

"means for supporting said pressure vessel in said clamping collar" (Claim 1);

"means for supporting said pressure vessel in said clamping collar;

means associated with said pressure vessel defining fluid inlet and outlet openings to and from the filter element and arranged for communication with said fluid inlet and outlet ports in said head to permit fluid flow through the filter;

said means associated with said pressure vessel comprising a closure member in sealed engagement with the end of said pressure vessel;

said means for supporting said pressure vessel in said clamping collar includes

a plurality of circumferentially spaced ledge surfaces formed on said clamping collar and

a plurality of circumferentially spaced ridge surfaces on said pressure vessel engageable with said ledge surfaces, . . .

said safety means comprising cooperating stationary stop means on said head and stop means on said clamping collar defining a predetermined limit of rotation of said clamping collar when removal of said pressure vessel from the filter assembly is desired and further comprising said circumferentially spaced ledge surfaces on said clamping collar which in cooperation with said ridge surfaces on said pressure vessel are effective during initial disengagement of said pressure vessel from said head to prevent the pressure vessel be blown from said head," (Claim 4); as well as similar language in Claim 5.

head. It is the *filter unit* which includes the replaceable filter element. Thus, the invention is, in broad terms, the provision of structures on the replaceable filter unit and the filter head which enable the connection and disconnection of those components to effect the replacement of the filter element, whether that element is encased in a sealed filter cartridge as is provided by Everpure, or in some other fashion, as is set forth in the '171 patent.

Once the purchaser uses the Cuno adapter combined with a Cuno cartridge to replace the filter element, that purchaser is, in effect, reconstructing the claimed invention. As set forth above, the Cuno adapter incorporates the structural features of the closure member of the claimed filter unit and enables the insertion of that adapter into the head to receive all of the benefits of the claimed invention, despite the fact that the original filter unit was not worn out.

Under the repair doctrine, Cuno is entitled to provide the filter element in its pressurized canister, but not the provision of the entire structure of fluid conduits, safety elements, and other claimed elements. Such reconstruction is not authorized merely because Cuno finds it difficult, or undesirable, to replace only the filter that is within the pressurized canister.

A subsidiary point not considered by the Federal Circuit majority other than in a footnote relates to language in the District Court opinion that the Everpure filter cartridge is an unpatented part of a patented combination: "The filter cartridge is simply a component in a patented combination and the owner has the right to preserve the useful life of the combination by the replacement of worn, unpatented components." *Everpure, supra*, 725 F. Supp. at 731. (Appendix, page A23). It is significant to note that

the '171 Everpure patent *does* contain separate claims to the filter unit, specifically claims 7-10, and thus the filter unit is separately patented.² The mere existence of independent patent claims on the filter unit reflects the intent of Everpure to consider the filter unit "a material part of the invention" and not merely an unpatented, expendable wearing part such as a razor blade, a cutting blade, or even a convertible top fabric as has been considered in the cases cited by Cuno in the lower courts, including *Gillette, Porter*, and *Aro I* and *II*.

Thus, the doctrine of permissible repair is and should be properly limited to the repair or replacement of those elements—and only those elements—that are spent or worn out. The replacement of other elements in the patented combination, which are not themselves exhausted, remains a prohibited infringement unprotected by the necessity for repair. Accordingly, Cuno's sale of a replacement cartridge with an adapter which substitutes Cuno's parts for unworn and still operable Everpure parts in the patented combination, constitutes infringement.

B. The Federal Circuit Neglected to Consider the Effect of 35 U.S.C. §§271(b) and (c) on the Present Case.

The Federal Circuit cited, but then all but ignored, 35 U.S.C. §271 in reaching its decision. The contributory infringement prohibitions of §§271 (b) and (c)³ are directly

² Claims 2 and 3, also not asserted, relate to the filter head, and claims 11 and 12 relate to the closure of the cartridge.

³ §271(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever sells a component of a patented machine, manufacture, combination or composition or a material or apparatus for

(Footnote continued on following page)

applicable to the present facts and must necessarily provide the starting point for analysis.

As indicated by this Court in *Aro II*, Congress enacted §271 for "the express purpose of reinstating the doctrine of contributory infringement as it had been developed by decisions prior to *Mercoid*,⁴ and of overruling any blanket invalidation of the doctrine that could be found in the *Mercoid* opinions. See, e.g. 35 U.S.C. §§271(c) and (d)". *Aro II, supra*, 377 U.S. at 492. Also, "that purpose [of Congress in urging passage of §271(c)] is essentially, as was stated in the earlier versions of the bill that became §271(c) 'to provide for the protection of patent rights where enforcement against direct infringers is impracticable'." *Id.* at 511.

Section 271 restored the result and sound reasoning of some prior decisions, most notably *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 325 (1909). In *Leeds & Catlin*, the doctrine was upheld against a manufacturer of phonograph discs, which discs were not separately patented, but which were specially designed for use in the patented combination. The Court there noted that the disc itself, while not separately patented, was essential to the functioning of the patented combination, and the method of interaction with the stylus was

³ *continued*

use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

⁴ *Mercoid Corp. v. Mid-Continent Investment Co.*, 320 U.S. 661 (1944); *Mercoid Corp. v. Minneapolis-Honeywell Regulator Co.*, 320 U.S. 680 (1944).

what "mark[ed] the advance upon the prior art". *Id.* at 330.

In *Dawson Chemical Co. v. Rohm & Haas Co.*, 448 U.S. 176 (1980), this Court also noted that "by enacting §§271(c) and (d) Congress granted to patent holders a statutory right to control nonstaple goods that are capable only of infringing use in a patented combination, and that are essential to that invention's advance over the prior art." *Id.* at 213.

Everpure's cartridge, with its unique interlocking and quick change feature, is essential to the invention's advance over the prior art and there can be no dispute that it is a material part of the invention. Cuno supplies cartridges for use with its own system; however, as previously stated, the cartridges are not compatible with Everpure's head—they do not fit or function with the Everpure filter assembly. Cuno has gone to great lengths to design an adapter which is especially made to enable a normally incompatible Cuno cartridge to fit and function within the Everpure head. The adapter includes structures which mimic the unworn parts of Everpure's cartridge. It duplicates the sealing means of Everpure's cartridge and provides securing wings which are a structural duplication of the ridge surfaces on Everpure's pressure vessel to obtain the benefits of the invention; thus, it reconstructs the original Everpure assembly. Further, Cuno is not providing a staple article or commodity of commerce suitable for substantial noninfringing use.

Cuno's conduct meets all of the elements of contributory infringement. Cuno supplies "a component of a patented . . . combination . . . constituting a material part of the invention"; Cuno "know[s] the same to be especially made or especially adapted for use in an infringement of such

patent"; and the adapter is "not a staple article or commodity of commerce suitable for substantially noninfringing use." 35 U.S.C. §271(c).

C. The Federal Circuit Failed to Appreciate the Uniqueness of the Present Case in View of the Relationship Between 35 U.S.C. §271(c) and the Doctrine of Repair/Reconstruction.

The decisions discussed hereinabove are ample evidence of the fact that there is a delicate balance between the public policy behind the judicially created doctrine of permissible repair, *i.e.*, that a purchaser of a patented system should be able to make repairs where necessary of worn or broken components to prolong the useful life of that purchased patented product, and the intent of Congress in enacting §271(c), *i.e.*, to protect the patentee from erosion of its patent grant by actions of those who would not be considered direct infringers, but who provide the incentive and/or the wherewithal of others to become direct infringers.

In the present case, where the filter head and the filter cartridge individually, as well as the combination, are all patented, and where it is the means of connection of the filter cartridges with the filter head which provides the invention with its stated advantages, and where neither of these components becomes worn, broken or spent through use, the replacement of such components, such as by the "adapter" in the present case, constitutes unlawful reconstruction under the doctrine of repair. If the replacements are provided by a party knowing the components to be patented, that party is a contributory infringer.

CONCLUSION

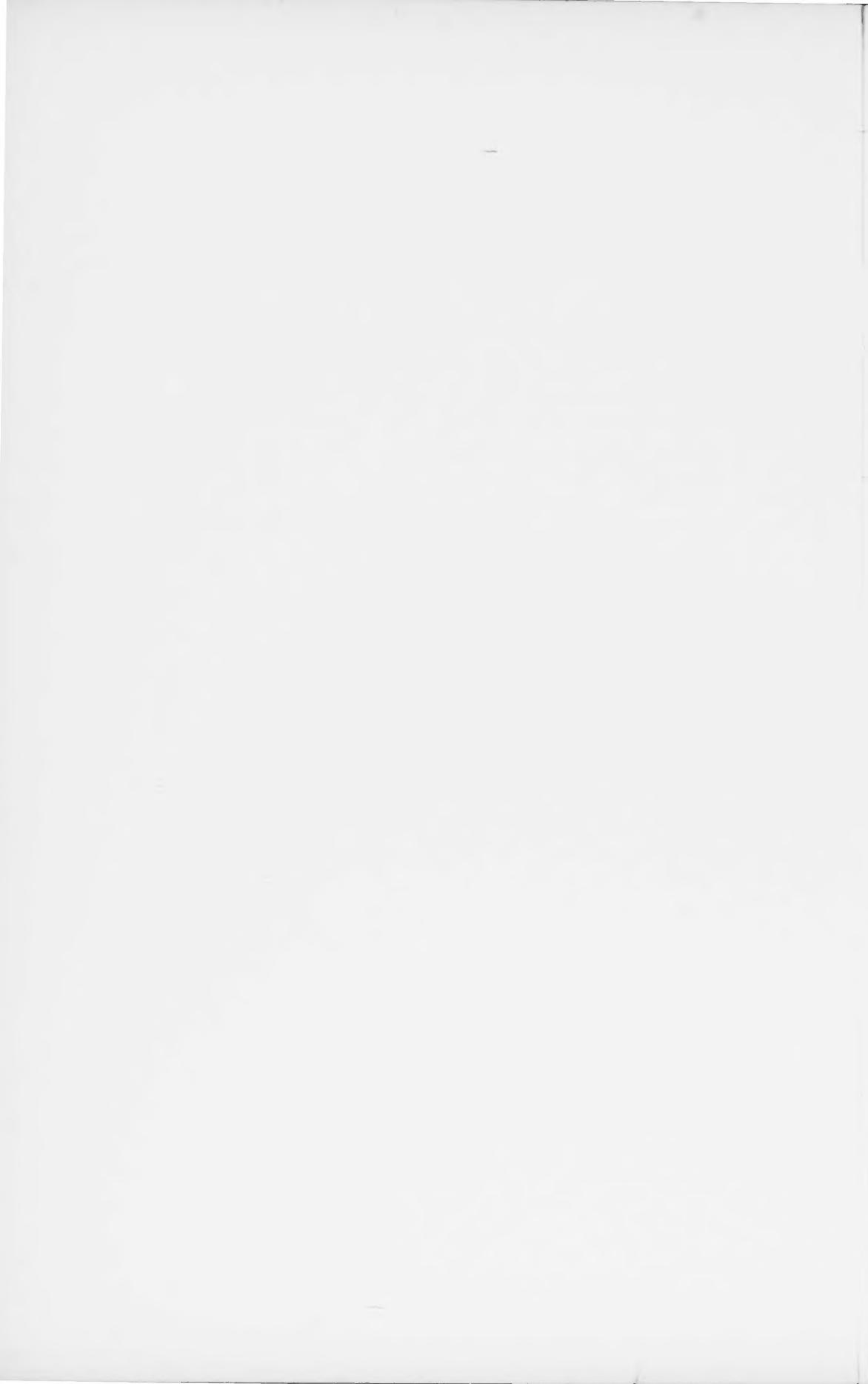
This Petition for Writ of Certiorari should be granted by this Court in the exercise of its supervisory powers. It should be granted because the decision of the Federal Circuit seriously conflicts with applicable decisions of this Court and is contrary to the intent of the applicable statutes.

Respectfully submitted,

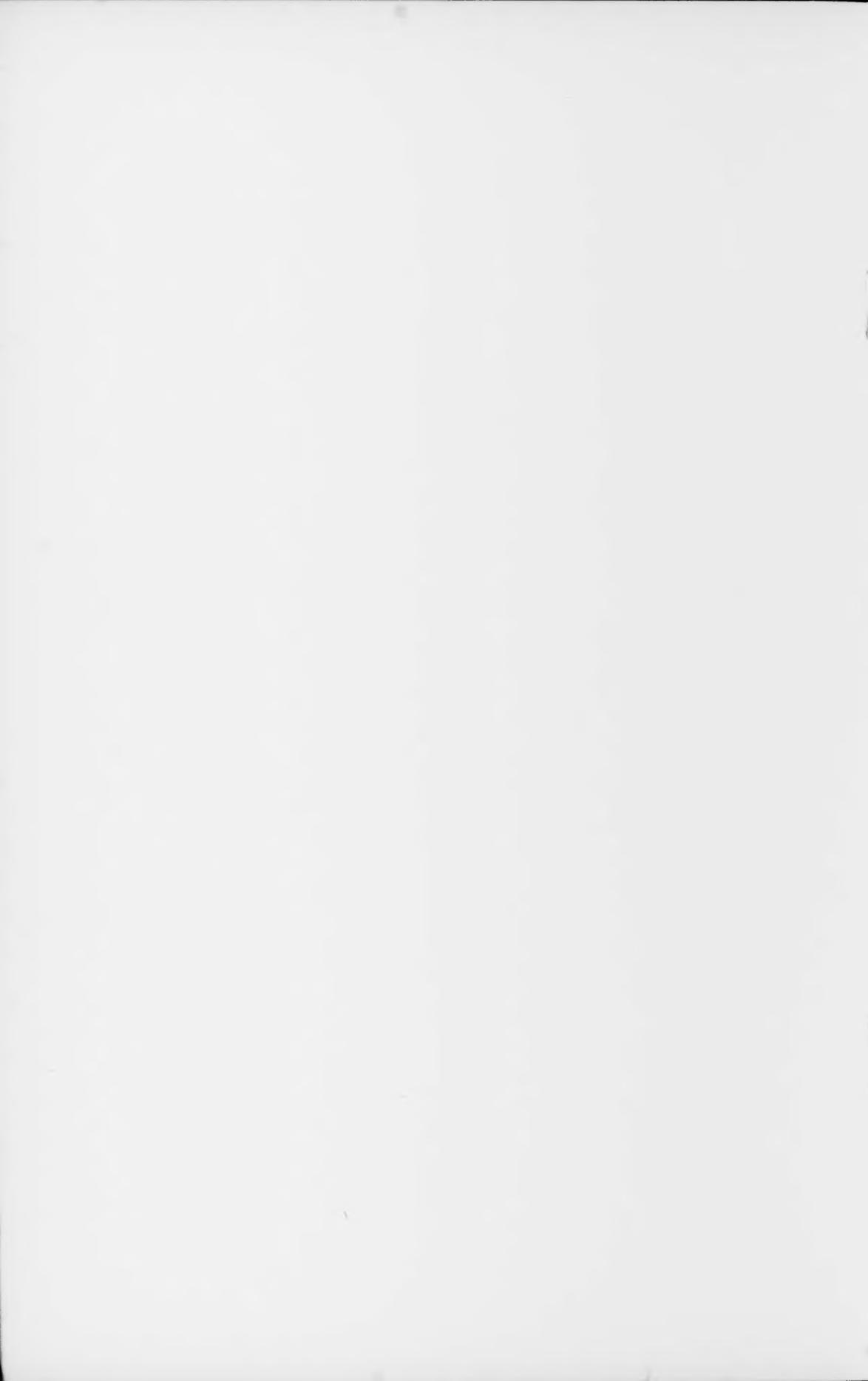
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APPENDIX



875 F.2d 300
10 U.S.P.Q.2d 1855

(Publication page references are not available for this document.)

EVERPURE, INC., Plaintiff-Appellant,

v.

CUNO, INC., Defendant/Cross-Appellant.
Nos. 88-1612, 88-1613.

United States Court of Appeals,
Federal Circuit.
May 17, 1989.

Before MARKEY, Chief Judge, NICHOLS, Senior Circuit Judge, and NEWMAN, Circuit Judge.

MARKEY, Chief Judge.

Everpure, Inc. (Everbpure) appeals from a July 21, 1988 summary judgment of the United States District Court for the District of Connecticut, No. CIVIL N-88-170 PCD (Dorsey, J.), based on a finding that Cuno Inc. (Cuno) did not infringe claims 1, 4, 5, and 6 of Everpure's United States Patent No. 3,746,171 ('171). Cuno cross-appeals the denial of attorney fees and Rule 11 sanctions and requests attorney fees on appeal. We affirm in all respects and deny Cuno's request for attorney fees on appeal.

BACKGROUND

The asserted claims of Everpure's '171 patent are drawn to the combination of a head and an attached filter cartridge. The neck of the cartridge is removably inserted into the head and has channels for directing fluid to and from a filter sealed within the cartridge. When Everpure's filter wears out, it sells entire cartridges for periodic replacement during the much longer life span of the head.

Cuno supplies, free of charge to its customers, an adapter that enables attachment of a Cuno cartridge to an Everpure head. The adapter performs the function of the neck of Everpure's cartridge.

District Court Opinion

Everpure sued Cuno for contributory and induced infringement. Cuno moved for summary judgment of non-infringement, alleging that replacement of Everpure's cartridges constituted permissible repair.¹ The district court granted Cuno's motion as a matter of law, finding no genuine issue of material fact as to contributory or induced infringement of the asserted claims. The district court reasoned:

It is not without significance that the cartridge consists of the internal material which accomplishes the filtering process. Specifically, the casing contains the filtering element which receives, filters, and discharges the fluid from and to the filter head to which it interconnects. It is the filtering element, not the casing, which eventually wears out. Yet, the patent speaks of "a replaceable filter unit." The objects of the patent are a quickly and easily removable filter unit achieved by a clamping collar which connects the filter unit and head. When used in conjunction with the pressure vessel, the clamping collar allows for the assembly and disassembly of the filter unit and head while it is under pressure without the loss of fluid.

* * *

Here it is the combination that is protected. The cartridge is not. Defendant is neither contributing to nor inducing a direct infringement of plaintiff's product. A purchaser of plaintiff's filter unit is free to replace the worn out filter cartridge and the fact that it requires a particular cartridge configuration to mate it to the head does not alter the legal principle. The filter cartridge is simply a component in a patented combination and the owner has the right to preserve the useful life of the combination

¹ Everpure moved for preliminary injunction. Cuno's motion for summary judgment included allegations of patent misuse, inequitable conduct, and invalidity. Everpure's motion and Cuno's allegations were not considered by the district court and thus are not before us.

by replacement of worn, unpatented components. Defendant's sale of a unit with an adapter to permit that mating is no different than selling a single cartridge that conforms to the configuration of the head. This does not constitute infringement as a matter of law. *Special Equip. Co. v. Coe*, 324 U.S. 370, 376, 65 S.Ct. 741, 744, 89 L.Ed. 1006 (1925) (unpatented part of a combination patent may be appropriated by anyone).

The district court denied Cuno's motion for attorney fees, finding this not an "exceptional case", 35 U.S.C. § 285 (1982) because Everpure's position was not "so unsound as to have been frivolous." The district court denied Cuno's request for sanctions under Rule 11, Fed.R.Civ.P., because Cuno failed to show that a reasonable inquiry was not made before suit was brought.

ISSUES

1. Whether the district court erred in granting summary judgment of non-infringement.
2. Whether the district court erred in denying Cuno's motion for attorney fees and sanctions.
3. Whether Cuno is entitled to attorney fees on appeal.

OPINION

Summary Judgment

Summary judgment may be granted where "there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law." Fed.R.Civ.P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24, 106 S.Ct. 2548, 2553, 91 L.Ed.2d 265 (1986). Summary judgment is appropriate here because there can be neither contributory nor induced infringement when, because of the permissible repair doctrine, there has been no direct infringement. *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 341, 81 S.Ct. 599, 602, 5 L.Ed.2d 592, 128 USPQ 354, 357 (1961); *Met-Coil Sys. Corp. v.*

Korners Unlimited, Inc., 803 F.2d 684, 687, 231 USPQ 474, 477 (Fed.Cir.1986). The doctrine of permissible repair allows one lawfully using a patented combination to preserve and maintain the combination by making repairs or replacing unpatented component parts necessary for continued use. *Porter v. Farmers Supply Serv., Inc.*, 790 F.2d 882, 885-86, 229 USPQ 814, 816 (Fed.Cir.1986).²

Everpure says summary judgment was inappropriate because the repair/reconstruction dispute raises a genuine issue of material fact, namely, whether the filter is itself replaceable. Everpure argues that the permissible repair doctrine would permit replacement of only a worn part, such as the filter. It also says Cuno's adapter constitutes impermissible reconstruction because: (1) the adapter replaces an unworn part (the neck) of Everpure's cartridge; and (2) the adapter changes the structure and operation of the patented combination by rearranging the direction of water flow through the cartridge.

Everpure correctly states that it is replacement of worn or spent parts in a patented combination that constitutes repair and not reconstruction. *Porter*, 790 F.2d at 886, 229 USPQ at 816 (collecting authorities). Everpure, however, is "hoist on its own petard", for it seals its filter into its cartridge. Everpure and Everpure alone made the business decision to sell disposable cartridges and to render its filter irreplaceable without replacement of the entire cartridge. Everpure submitted no affidavit that would raise a material fact question on whether owners of Everpure's assembly could expose and replace the filter without cutting, bending, distorting, and then rebuilding, the cartridge. That such action by the owner of the combination is neither practical nor feasible is illustrated by the label on Everpure's disposable cartridge. That label emphasizes "Quick Change Cartridge", instructs owners to

² Non-asserted claims 7-12 are drawn to the details of Everpure's unitary cartridge and to its closure. Everpure has not challenged the district court's reference to replacement of "unpatented" parts.

"Service with a new cartridge . . . at least once a year", and contains illustrated instructions on changing the cartridge, not the filter. Thus Everpure has designed and conducts a business scenario in which the entire cartridge, including its sealed-in neck and filter, is spent when the filter wears out.³ It is at least difficult to accept the notion that one who purchases a disposable cartridge under instructions to replace it at least yearly is guilty of infringement when the buyer does precisely that.

Replacement of the spent cartridges in this case is clearly repair and not reconstruction. See *Payne v. Dickinson*, 109 F.2d 52, 54, 44 USPQ 181, 183 (3d Cir.), cert. denied, 310 U.S. 637, 60 S.Ct. 1080, 84 L.Ed. 1406 (1940) (not practicable for owner to replace worn needle securely inserted in hub; possible at factory but "well nigh impossible" with facilities at owner's command); *Electric Auto-Lite Co. v. P. & D. Mfg. Co.*, 109 F.2d 566, 567, 44 USPQ 377, 379 (2d Cir. 1940) (Circuit Judges L. Hand, A. Hand, and Chase writing per curiam) (buyer entitled to replace entire breaker arm, not just the worn-out contact points attached to the arm; repair theory rests on patentee's intent that buyer have longer use than the life of the shortest-lived part).⁴

That the channels in the neck of Everpure's unpatented cartridge and those in the adapter are different is inconsequential. First, the neck is part of the spent cartridge. Second, "there is no legally recognizable or protected 'essential' element, 'gist' or 'heart' of an invention in a

³ The '171 patent specification says the entire cartridge is preferably disposable but could be made in three separate parts (casting, closure, and filter), in which case only the filter would be replaced. The latter circumstance is not present here.

⁴ Everpure puts much store by *Automotive Equipment Co. v. Connecticut Telephone & Electric Co.*, 19 F.2d 990 (3d Cir.), cert. denied, 275 U.S. 564, 48 S.Ct. 121, 72 L.Ed. 428 (1927). We agree with the courts in *Payne*, which ignored, and *Electric Auto-Lite*, which declined to follow, *Connecticut Telephone*.

combination patent." *Aro*, 365 U.S. at 345, 81 S.Ct. at 604, 128 USPQ at 359. As the district court indicated, it is of no moment that Cuno chose to supply an adapter with its cartridge, rather than supplying a cartridge otherwise compatible with Everpure's head. The change in water flow does not constitute reconstruction because the direction of flow is irrelevant to the nature and function of the patented combination.

In sum, a buyer commits no direct infringement of claims 1, 4, 5, or 6 when replacing Everpure's spent cartridge with an adapter-cum-cartridge, and, as above indicated, without direct infringement there can be no contributory or induced infringement.

Attorney Fees and Sanctions

In view of the novelty of the present fact pattern, i.e., use of an adapter to facilitate repair by replacement of a spent, disposable part of a patented combination, we cannot say the district court abused its discretion in denying Cuno's motion for attorney fees and Cuno's request for Rule 11 sanctions. See *Pennwalt Corp. v. Akzona Inc.*, 740 F.2d 1573, 1582, 222 USPQ 833, 839 (Fed.Cir.1984); *Woodcrest Nursing Home v. Local 144, Hotel, Hospital, Nursing Home and Allied Services Union*, 788 F.2d 894, 899 (2d Cir.1986).

Though Everpure's effort to force a trial to determine whether its filter is itself replaceable is regrettable in the face of all the undisputed facts, its argument on the adapter moves this appeal just over the line marked "frivolous". Hence, we can neither declare this appeal frivolous nor award attorney fees. Fed.R.App.P. 38.

AFFIRMED.

PAULINE NEWMAN, Circuit Judge, dissenting.

It is not disputed that the installation and use of Cuno's "adapter" and filter cartridge would be an infringement of the Everpure patent, unless both of these elements are within the exception of the principle of permissible repair. The filter cartridge may qualify, as Everpure concedes, in that it replaces the spent filter. But the "adapter" does not. Thus I respectfully dissent from the court's decision.

The patented invention is a filter assembly for purifying water. The so-called "adapter" comprises a major portion of the claimed assembly, as is apparent from the claims. Claim 4 is typical (letters (a)-(m) added):

4. A filter assembly comprising:
 - (a) a head adapted to be fixedly mounted;
 - (b) fluid inlet and outlet ports formed in said head;
 - (c) first cam surfaces on said head;
 - (d) a clamping collar having second cam surfaces engageable with said first cam surfaces and cooperating therewith so that rotation of said collar in one direction causes axial movement of said collar from a clamping to an unclamped position and rotation in an opposite direction returns said collar to a clamping position;
 - (e) a pressure vessel having a filter element disposed therein;
 - (f) means for supporting said pressure vessel in said clamping collar;
 - (g) means associated with said pressure vessel defining fluid inlet and outlet openings to and from the filter element and arranged for communication with said fluid inlet and outlet ports in said head to permit fluid flow through the filter;
 - (h) said means associated with said pressure vessel comprising a closure member in sealed engagement with the end of said pressure vessel,

- (i) said means for supporting said pressure vessel in said clamping collar includes
- (j) a plurality of circumferentially spaced ledge surfaces formed on said clamping collar and
- (k) a plurality of circumferentially spaced ridge surfaces on said pressure vessel engageable with said ledge surfaces,
- (l) safety means for preventing fluid under pressure in the system in which the filter assembly is disposed from blowing said pressure vessel from said head in the event removal of the pressure vessel is attempted before shutting off the supply of fluid to the head,
- (m) said safety means comprising cooperating stationary stop means on said head and stop means on said clamping collar defining a predetermined limit of rotation of said clamping collar when removal of said pressure vessel from the filter assembly is desired and further comprising said circumferentially spaced ledge surfaces on said clamping collar which in cooperation with said ridge surfaces on said pressure vessel are effective during initial disengagement of said pressure vessel from said head to prevent the pressure vessel being blown from said head.

The principal advantage of the claimed filter assembly is that the filter element can be replaced without turning off the water supply and without blowing the pressure vessel from the head. This is achieved by construction of the overall assembly in two parts: a fixed part and a separable part, whose elements interact to achieve, together, the purposes of the invention.

The fixed part, called the head, is permanently attached to the water line. Claim clauses (a)-(d) and portions of clauses (i)-(j) and (l)-(m) define elements of the head.

The separable part comprises the remaining claim elements: claim clauses (e)-(h) and cooperating components of clauses (i)-(k) and (l)-(m). Included are not only the pressure vessel containing the filter element, clause (e), but also all the elements that are housed in the "adapter":

the conduits that coordinate with the fluid paths in the head, the support and closure members, the safety means, and the leak-proof attachment. The specification refers to this entire separable part as the "replaceable filter unit", thereby distinguishing it from the fixed head. It is this entire unit the replacement of which the district court authorized as, simply, "repair".

In the commercial Everpure filter assembly all the elements of the "replaceable filter unit" are housed together in a cartridge. Cuno provides all these elements, but in two units. One unit contains the filter in a pressurized container, claim clause (e). The other unit, the Cuno "adapter", contains the elements of claim clauses (f)-(h) and the cooperating components of clauses (i)-(k) and (l)-(m). No part replaced by the Cuno "adapter" is worn out, exhausted, broken, or in need of repair.

As Cuno states the argument, because all these elements are sealed in the cartridge with the filter, as sold by Everpure, all are deemed spent when the filter is spent. Thus the district court held that Cuno's entitlement to replace the spent filter necessarily means entitlement to replace everything in the Everpure cartridge.

Discussion

The doctrine of permissible "repair" authorizes the replacement of worn or broken parts, but only when such replacement does not amount to "reconstruction" of the patented invention. The principle was stated in *Aro Manufacturing Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345, 81 S.Ct. 599, 604, 5 L.Ed.2d 592, 128 USPQ 354, 359 (1961), that the law authorizing "repair" of a patented device relates to the "preserv[ation of] fitness to use so far as it may be affected by wear or breakage", quoting *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 325, 326, 29 S.Ct. 503, 503, 53 L.Ed. 816 (1909). The Court distinguished "reconstruction" as "a second creation of the patented entity". *Aro*, 365 U.S. at 345-46, 81 S.Ct. at 604, 128 USPQ at 358.

There is no automatic right to replace unworn, unbroken parts of a patented structure simply because the unworn part is sold or used in attachment to a worn part. While there is no bright line between permissible repair and impermissible reconstruction, in this case the "adapter" is plainly in the category of reconstruction. The only question is whether such reconstruction must be tolerated because it accompanies replacement of the spent filter.

The district court appears simply to have redefined reconstruction as repair, then holding that repair is permissible. The court said that "the fact that it requires a particular cartridge configuration to mate it to the head does not alter the legal principle" of permissible repair. This conclusion ignores the controlling fact that the "adapter" is not merely a "configuration to mate it to the head". It is not a simple plug. It is a material and complex part of the total claimed invention.

Guidance arises from decisions of this court reviewing whether particular facts support "repair" or "reconstruction". See, e.g., *Lummus Industries Inc. v. D.M. & E. Corp.*, 862 F.2d 267, 272, 8 USPQ2d 1983, 1987 (Fed.Cir. 1988) (replacement of unpatented reel that is not worn is not repair but "a second creation of the patented entity", quoting *Aro, supra*); *Dana Corporation v. American Precision Co.*, 827 F.2d 755, 3 USPQ2d 1852 (Fed.Cir. 1987) (it is permissible repair to replace defective or worn parts of clutches with used or new parts, where no more than four parts of the many-part clutches were new); *Porter v. Farmers Supply Service, Inc.*, 790 F.2d 882, 229 USPQ 814 (Fed.Cir.1986) (replacement of worn-out unpatented disks of harvesters was permissible repair, the court referring to the relative costs of the disks (\$79.50) and the harvester (\$42,400)).

The district court may have been led into error by misapplication of its conclusion that because an "unpatented part of a combination patent may be appropriated by anyone, *Special Equipment Co. v. Coe*, 324 U.S. 370, 376, 65 S.Ct. 741, 744, 89 L.Ed. 1006 (1945)", Cuno can freely

provide any unpatented component of the combination. *Special Equipment* does not so hold. 35 U.S.C. § 271(c) specifically states the contrary.¹ The district court's reliance on *Special Equipment* suggests misunderstanding of the law of contributory infringement as well as the law of repair/reconstruction.

The panel majority relies on *Payne v. Dickinson*, 109 F.2d 52, 44 USPQ 181 (3rd Cir.1940), where the claimed combination was a hypodermic syringe and a needle sealed into a "hub" adapted to fit the syringe, and the court held that it was permissible repair to replace the worn or broken needle with its hub; and on *Electric Auto-Lite Co. v. P. & D. Mfg. Co.*, 109 F.2d 566, 44 USPQ 377 (2d Cir.1940) wherein the court held that it was permissible repair to replace a breaker-arm instead of solely the worn contact points it contained, distinguishing an earlier, contrary case on the basis that it had now become cheaper to replace the breaker-arm than to replace the points. These cases support the proposition that Cuno is entitled to provide the filter in its pressurized canister, but they do not support Cuno's additional provision of the entire structure of fluid conduits, safety elements, and other claimed elements.

The multiple elements contained in the "adapter" are neither worn nor broken, and do not require repair. Cuno's argument that unless it provides these elements it can not provide the new filter is a recognition that it has reconstructed the total assembly. Such reconstruction

¹ 35 U.S.C. § 271(c):

Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

is not authorized merely because Cuno finds it difficult, or impossible, to replace the filter in the pressurized canister.

The doctrine of permissible repair is a carefully evolved exception to the law of infringement. The integrity of the patent grant requires that permissible repair be limited to that which can be made without reconstruction. If the asserted repair also requires reconstruction, it can not be deemed to constitute an exception to the principles of infringement. The right to exclude others from practice of the patented invention is eviscerated if others are authorized to reconstruct a material portion thereof simply because the worn part of the patented structure is not readily repaired or replaced.

I would reverse the judgment of the district court.

705 F.Supp. 725
(Cite as: 705 F.Supp. 725)

EVERPURE, INC.

v.

CUNO, INC.

Civ. No. N-88-170 (PCD).

United States District Court, D. Connecticut.

July 21, 1988.

RULING ON MOTION FOR
PRELIMINARY INJUNCTION and
MOTION FOR SUMMARY JUDGMENT

DORSEY, District Judge.

Plaintiff alleges infringement by defendant of its Patent No. 3,746,171 ('171).¹ Pending are the following motions on which a hearing has been held and briefing has been completed: (a) plaintiff's motion for a preliminary injunction; and (b) defendant's motion for summary judgment and attorney fees pursuant to Fed.R.Civ.P. 11 and 35 U.S.C. § 285. A recitation of the undisputed facts is necessary for decision of both motions.

I. Facts

Plaintiff has been issued patent '171 for filtration equipment with an expiration of July 17, 1990. The patent describes a fixed head to which a replaceable filter cartridge is attached by a locking mechanism. The device is designed to be used with vending machines, commercial ice machines, and commercial coffee makers, all of which require *727 highly purified water for product quality. Plain-

¹ Plaintiff's patent is presumed to be valid, 35 U.S.C. § 282, and it is the burden of the challenger to establish invalidity clearly and convincingly. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1443-44 (Fed.Cir.), cert. denied, 468 U.S. 1228, 105 S.Ct. 32, 82 L.Ed.2d 923 (1984).

tiff manufacturers [sic] and sells both filtration units and replacement cartridge filters.² It enjoys a significant market share partially because of the uniqueness of its filter's interconnection to its filtration head.

Plaintiff does not claim patent protection for the filtration function nor the filter cartridge itself, but rather for the filter cartridge and the head which are combined by means of an interlocking mechanism. That mechanism is created by the configuration of the neck of the filter cartridge, Exhibit 3B, which is inserted into, interconnects, and interlocks with the configuration of the filtration head. Exhibit 3A. Water is received through an inlet port in the head and passes into and through the cartridge, an escape port, an outlet line from the head, and then into the machine to which the filtration unit is attached. The head includes a manual valve which shuts off the water inlet. The valve control lever interlocks with a collar to prevent rotation of the cartridge and therefore connection until the valve is closed. The pressure within the filtration unit is diffused upon the disconnection of the cartridge.

The filter cartridge wears out, requiring periodic replacement during the much longer life span of the head. Replacing the cartridge requires no tools, eliminates the need for a remote water shut-off, is relatively simple and quick to accomplish, involves no spillage, and can be done without pressure in the waterline or the filtration unit as it is diffused before disconnection and the interlock prevents rotation of the collar until the water supply valve is closed.

Defendant also manufactures and sells water filters, Exhibit 5A, and replacement cartridges. Exhibit 5B. Its car-

² Replacement filter cartridges vary in length and internal filtering configurations for specific uses, variations which are not relevant here. It is the configuration of the upper end of the cartridge that interconnects and interlocks with the head unit that is the subject of the '171 patent.

tridges are designed to be used with its filtration head and in such form are not compatible with plaintiff's head. To broaden its access to the replacement cartridge market, defendant has manufactured an adapter, Exhibit 6A, which is designed to be attached to defendant's cartridge. The adapter duplicates the configuration of the neck of plaintiff's cartridge and thus permits one of defendant's cartridges to be inserted into and interlocked with one of plaintiff's heads. The adapter is not shown to have any useful purpose other than to permit defendant's cartridges to be used with plaintiff's filter head. Defendant markets its filters for such use at competitive prices, supplying the adapter without additional charge to owners of a head supplied by plaintiff.

II. Claims

Plaintiff alleges contributory infringement of claims 1, 4, 5 and 6, which describe the filter head, the filter, cartridge, and the clamping mechanism created by the interrelated configurations of its cartridge and head. Because the patent covers the filter head and cartridge in combination, the claim of infringement must pertain to the combination. Yet defendant does not manufacture nor sell a head comparable to plaintiff's, only the cartridge, providing the adapter to permit use of its cartridge with plaintiff's head. Thus, until defendant's cartridge is connected by its adapter to the head manufactured by plaintiff, there is no infringement. Defendant's alleged infringement occurs because it contributes to and/or induces the user to connect defendant's cartridge with plaintiff's head by use of the adapter. 35 U.S.C. § 271(b) and (c).³ Plain-

³ Section 271, in pertinent part, provides:

- (b) Whoever actively induces infringement of a patent shall be liable as an infringer.
- (c) Whoever sells a component of patented machine, manufacture, combination or composition, or a material or apparatus

(Footnote continued on following page)

tiff seeks injunctive relief to preserve *728 its patent and the attendant market monopoly.

Defendant claims: (1) Its sale of cartridges for use with its adapter constitutes a permissible repair and not an infringement; (2) plaintiff's unrestricted sale of its heads creates an implied license and defendant thus cannot be found to infringe; (3) plaintiff's claim constitutes misuse of its patent; (4) plaintiff is barred from enforcement of its patent by reason of its inequitable conduct before the United States Patent Office ("USPO"); and (5) plaintiff's patent is invalid by reason of sale and use prior to patent application.

III. Discussion

As a favorable ruling on defendant's motion would resolve the case, thus moot plaintiff's motion for a preliminary injunction, defendant's motion will be considered first.⁴

A. Summary Judgment Standard

Summary judgment may properly be granted where there is no dispute as to the material facts and it is clear that the movant is entitled to judgment as a matter of law. Fed.R.Civ.P. 56; *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24, 106 S.Ct. 2548, 2553-54, 91 L.Ed.2d 265 (1986). A court is not authorized to resolve factual questions on such a motion; rather, its task is to determine if any such fac-

³ *continued*

for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

⁴ Denial of defendant's motion would permit consideration of plaintiff's motion without compromise of either party.

tual questions exist. If such questions exist, and if they are material to the claims in issue, then the non-moving party has met its burden and summary judgment is improper. *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 973-74 (Fed.Cir.1985); *Lemelson v. TRW, Inc.*, 760 F.2d 1254, 1260-61 (Fed.Cir.1985). "Further, as an additional precaution against denying a party its chance to prove a worthy case, any doubt as to the presence or absence of disputed issues of material fact must be resolved in favor of the presence of disputed issues, or in other words in favor of the party opposing summary judgment." *Lemelson*, 760 F.2d at 1261.

The onus placed upon a movant for summary judgment on a claim of inequitable conduct is especially heavy, as the claim necessarily involves determinations as to the intent of the party accused of practicing the fraud and the materiality of his alleged misrepresentations or omissions—issues which are typically not appropriate for resolution in a summary fashion. *Kangaroos U.S.A., Inc. v. Caldor, Inc.*, 778 F.2d 1571, 1573-74, 1577 (Fed.Cir.1985) (holding that evaluation of the intent element of inequitable conduct "is rarely enabled in summary proceedings"). Furthermore, in relation to a claim of infringement, summary judgment is proper where there is no genuine issue of material fact, the claims are properly construed and a finding of infringement is impossible. *Porter v. Farmer's Supply Serv., Inc.*, 790 F.2d 882, 884 (Fed.Cir. 1986).

1. Permissible Repair

Defendant first asserts its sales are permissible repair. 4 D. Chisum, Patents, § 16.03[3] (1987). This principle permits one lawfully using something covered by a patent to preserve and maintain the item in a usable, functional status by repairing the item, including replacing its component parts, without being accused of infringement. If the user has not directly infringed, there likewise can be no contributory infringement, *Aro Mfg. Co. v. Convertible*

Top Replacement Co., 365 U.S. 336, 340-46, 81 S.Ct. 599, 601-05, 5 L.Ed.2d 592 (1981) ("Aro I"), nor induced infringement, *Met-Coil Systems Corp. v. Corners [sic] Unlimited, Inc.*, 803 F.2d 684, 687 (Fed.Cir.1986). See *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 497, 84 S.Ct. 1526, 1537, 12 L.Ed.2d 457 (1964).

Defendant asserts the principle is applicable here because patent '171 involves a filter head which has a longer lifespan, Deposition of Richard Suda, Vol. 2, PP 19-21 (30-40 year lifespan), than the filter cartridge, *id.* at Vol. 1 at 156; Vol. 2 at *729 22-23 (3-12 month lifespan), and which, therefore, contemplates that the cartridge will be periodically replaced. In effect, defendant argues that one who purchases a filter unit covered by plaintiff's combination patent has the right to replace the cartridge without being limited to doing so with a cartridge supplied by plaintiff, but rather has the right to use any replacement cartridge. From this argument, it would follow that defendant has the right to supply a replacement cartridge made by defendant, including an adapter for compatibility.

Plaintiff's filter head fixes the unit in place, channels the water into and out of the filter cartridge and, by its configuration, in conjunction with the configuration of the cartridge, receives and holds the cartridge in place with the functional features set forth above. The internal design and make-up of the cartridge performs the actual filtering. The patent covers the entire unit, or combination of elements, and the totality of the patent claims. *Aro I*, 365 U.S. at 344, 81 S.Ct. at 603. Neither the head nor the cartridge, apart from their configuration as designed to permit their interconnection, are claimed to be separately protected by the '171 patent. Rather, the patent covers the combination of the two elements. The stated purpose of the patent, the description of the components and their interrelationship, the asserted unique features and advantages of the invention's function, in addition to the claims, make the patent one of totality. Indeed, the drawings display only the function, the uniqueness, the configurations

of the head and the cartridge as they achieve interconnection. Thus, the patent protects the interconnection of the head and the cartridge, the configurations of the head and the cartridge as they achieve the interconnection and the features produced in relation to the combined unit's function by the particular interconnection.⁵

Plaintiff does not dispute the repair principle, but claims the law authorizes only permissible repairs, not the reconstruction of a product as defendant has allegedly perfected by use of its adapter. Plaintiff relies on *Aro I*. Aro manufactured replacement convertible top fabrics "designed to fit the models of convertibles equipped with tops embodying the combination covered by the patent in suit." *Aro I*, 365 U.S. at 338, 81 S.Ct. at 600. The patent in issue included "a mechanism for sealing the fabric against the side of the automobile body in order to keep out the rain." *Id.* at 337, 81 S.Ct. at 600. The question decided by the Court of Appeals was whether Aro made "'a permissible replacement of a part [the fabric] which expectedly became worn out . . . sooner than other parts of the combination'" or "'a forbidden reconstruction of the construction.'" *Id.* at 338, 81 S.Ct. at 600, quoting *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 270 F.2d 200, 202 (1st Cir.1959). The Supreme Court saw the question as "whether the owner of a combination patent, comprised of unpatented elements, has a patent monopoly on the manufacture, sale or use of the several unpatented components of the patented combination." *Aro I*, 365 U.S. at 338-39, 81 S.Ct. at 600-01. It decided that neither the fabric nor its shape has been patented.

Defendant's standard filter cartridge does not have the cam surfaces nor interfacings that correspond to plaintiff's filter head. Instead of making its filter cartridge in a con-

⁵ See *Dawson Chem. Co. v. Rohm & Haas Co.*, 448 U.S. 176, 217, 100 S.Ct. 2601, 2623, 65 L.Ed.2d 696 (1980) (claim interpretation is a question of law); *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 565 (Fed.Cir.1986).

figuration to match plaintiff's filter, defendant has designed an adapter to make its cartridge the functional equivalent of plaintiff's cartridge. Thus, the question to be decided is: Does defendant's filter cartridge, with its adapter, constitute a repair or reconstruction as that issue has been defined by *Aro I* and its progeny?⁶

*730 It is not without significance that the cartridge consists of the internal material which accomplishes the filtering process. Specifically, the casing contains the filtering element which receives, filters, and discharges the fluid from and to the filter head to which it interconnects. It is the filtering element, not the casing, which eventually wears out. Yet, the patent speaks of "a replaceable filter unit." Exhibit 1 at 1. The objects of the patent are a quickly and easily removable filter unit achieved by a clamping collar which connects the filter unit and head. When used in conjunction with the pressure vessel, the clamping collar allows for the assembly and disassembly of the filter unit and head while it is under pressure without the loss of fluid.

The invention provides a unit of simple construction and use with a minimum number of parts. *Id.*, Col. 1-2. The preferred embodiment intends that the entire filter unit will be disposable and replaced, but the cartridge could be reusable with a need then to replace only the filter element. *Id.*, Col. 5, 6. There could be three parts to the filter unit, a pressure container, the internal filter element, and "closure members [which] would be detachably secured in the upper part of the pressure vessel." *Id.*, Col. 5, Lines 35-37. However, the purposes of the invention are best achieved by a single filter unit as described in the patent diagrams. *Id.*, Col. 5, Lines 40-49. Anything

⁶ There is no dispute as to the physical facts presented by defendant's cartridge and the adapter, nor how they function in relation to plaintiff's filter head. Thus, the only question is one of law. *Dana Corp. v. American Precision Co.*, 827 F.2d 755, 758-59 (Fed.Cir.1987).

other than the preferred embodiment would appear to lose the advantages stressed in the description of the patent's objects, such as changing only the filter element. *Id.*, Col. 6, Line 37, *et seq.* None of the claims treat the filter unit as separable into parts. Plaintiff's choice of patent claims does not permit it to claim an infringement based on what it might have done to isolate the part subject to wear.

Aro I holds that a patent must be viewed in its entirety. "No element, not itself separately patented, that constitutes one of the elements of a combination patent is entitled to patent monopoly, however essential it may be to the patented combination and no matter how costly or difficult replacement may be." *Aro I*, 365 U.S. at 345, 81 S.Ct. at 604. In relation to the repair doctrine, that means that courts are not to distinguish between a repair and a reconstruction merely because of the significance of the cost of the replaced or repaired item or because of the duration of its lifespan. *Id.* at 343-44, 81 S.Ct. at 603-04. "[T]here is no legally recognizable or protected 'essential' element, 'gist' or 'heart' of an invention in a combination patent." *Id.* at 345, 81 S.Ct. at 604, citing *Mercoid Corp. v. Mid-Continent Co.*, 320 U.S. 661, 667, 64 S.Ct. 268, 272, 88 L.Ed. 376 (1944); *Mercoid Corp. v. Minneapolis-Honeywell Co.*, 320 U.S. 680, 684, 64 S.Ct. 278, 280, 88 L.Ed. 396 (1944). Simply put, the right of a patent covering a combination of parts is "to preserve [the patented combination's] fitness for use so far as it may be affected by wear or breakage." *Leeds & Catlin Co. v. Victor Tolling [sic] Mach. Co.*, 213 U.S. 325, 336, 29 S.Ct. 503, 506, 53 L.Ed. 816 (1909). Preservation of the combination patent by replacement of a spent, unpatented element does not constitute reconstruction. Reconstruction occurs only when a new article is made. *United States v. Aluminum Co. of America*, 148 F.2d 416, 425 (2d Cir.1945). See also *Aro I*, 365 U.S. at 355, 81 S.Ct. at 609 ("none but the most extraordinary case" would require a determination that "there has actually been a new 'making' of the patented article"). Plaintiff, relying on *Leeds & Catlin Co.*, argues that defendant's adapter and replacement cartridge, as

connected to plaintiff's filter head, constitutes a reconstruction. In *Leeds*, infringement was claimed in the sale of records which could be played on patentee's voice reproducing machine. There, the records were not provided to permit continued use of the voice machine, but to expand the repertory of sound playable on patentee's machine by making available sound records other than records sold by patentee. The Court, holding that a combination patent applies to the combination as a unit, found that the record, or disc, interacted with the voice machine and constituted the patented combination. The discs, while fragile, were not perishable. Thus, the discs of the alleged *731 infringer were not purchased nor sold to replace worn discs, but to provide new discs with different recorded sound. They were thus an addition to a disc collection, not replacements.⁷ This scenario in *Leeds*, however, is not comparable to Everpure's filter elements which do wear out and require replacing to preserve the functioning quality of the unit.

In *Porter*, plaintiff sold a tomato harvester which incorporated a patented header. The header included a mechanism for driving the disks and a structure for supporting, positioning and adjusting the disks which rotated and were in contact with the plants. The disks were integrated into the header. A disk's life was measured in weeks, while a harvester would last five or six years. Plaintiff sold replacement disks for use on the patented header, as did defendant. Plaintiff sued, claiming defendant infringed the patent. The claims which allegedly were infringed described the harvesting process and the mechanism of the header, including the disks, by which the harvest is accomplished. The Court of Appeals sustained a finding of permissible replacement as replacement of worn disks did not constitute reconstruction. It held that,

⁷ Plaintiff cites no other case as involving comparable facts and holding that infringement occurred on the basis of a reconstruction rather than a permissible repair.

since the machine owner could not be found liable for infringement as he was merely replacing the spent disks—albeit with defendant's product—to restore his machine to operating quality, neither could defendant be held liable for indirect infringement.

A review of just some of the case law illustrates the applicability of the repair doctrine to patent '171 and defendant's alleged infringement thereof. See *Wilson v. Simpson*, 9 How. 109, 123, 13 L.Ed. 66 (1850) (planing machines' cutting knives could be replaced without violating patent; purchaser is entitled "to give duration to that which he owns"); *Heyer v. Duplicator Mfg. Co.*, 263 U.S. 100, 101, 44 S.Ct. 31, 32, 68 L.Ed. 189 (1923) (replacement of gelatin bands in a patented copying machine did not constitute reconstruction); *Dana Corp.*, 827 F.2d at 759-60 (replacement of component parts of a patented heavy-duty truck clutch because of wear was not reconstruction); *National-Standard Co. v. UOP, Inc.*, 616 F.2d 339 (7th Cir.1980) (replacement of sieve in apparatus for separating fine grain solids not reconstruction); *Wells Mfg. Corp. v. Littlefuse, [sic] Inc.*, 547 F.2d 346 (7th Cir.1976) (replacing switches in a patented vehicle stoplight mechanism not reconstruction); *Gillette Safety Razor Co. v. Standard Safety Razor Co.*, 64 F.2d 6, 17 (2d Cir.), cert. denied, 290 U.S. 649, 54 S.Ct. 66, 78 L.Ed. 562 (1933) (blades replaceable in razor).

Here, it is the combination that is protected. The cartridge is not. Defendant is neither contributing to nor inducing a direct infringement of plaintiff's product. A purchaser of plaintiff's filter unit is free to replace the worn out filter cartridge and the fact that it requires a particular cartridge configuration to mate it to the head does not alter the legal principle. The filter cartridge is simply a component in a patented combination and the owner has the right to preserve the useful life of the combination by replacement of worn, unpatented components. Defendant's sale of a unit with an adapter to permit that mating is no different than selling a single cartridge that conforms to the configuration of the head. This does not con-

stitute infringement as a matter of law. *Special Equip. Co. v. Coe*, 324 U.S. 370, 376, 65 S.Ct. 741, 744, 89 L.Ed. 1006 (1925) (unpatented part of a combination patent may be appropriated by anyone).

2. Implied License

Defendant argues that the purchaser of a filter unit designed by plaintiff obtains an implied license to use the filter head without the requirement of any further payment to plaintiff. This implied license arises because the filter unit design contemplates that the filter cartridge will have to be periodically replaced.

The facts demonstrate that plaintiff imposes no restrictions on the buyers of its filter units. The unit is, of course, of no *732 use to an owner except to perform the filtering function for which it was designed and in accordance with the patent. Furthermore, as the filter element only lasts a limited time, and as plaintiff manufactures replacement cartridges, the unit is clearly not intended to be limited to the useful life of the filter element. It will be replaced from time to time during the useful life of the head. While these facts do not suggest that plaintiff's purchasers had an express license to use the filter head with replacement cartridges, they certainly suggest that such a license was implied. *United States v. Univis Lens Co.*, 316 U.S. 241, 249-51, 62 S.Ct. 1088, 1092-93, 86 L.Ed. 1408 (1942). It is only reasonable that a buyer would expect to use the unit for its designed purpose. *Beckman Instruments, Inc. v. Technical Development Corp.*, 730 F.2d 1076, 1086 (7th Cir.), cert. denied, 469 U.S. 858, 105 S.Ct. 187, 83 L.Ed.2d 120 (1984). Such a license gives plaintiff's purchasers the right to use replacement cartridges designed by defendant and protects defendant from a claim of infringement. *Met-Coil Systems Corp.*, 803 F.2d at 686.

Plaintiff has cited no case and made no sound argument to support the inapplicability of the implied license principle. It suggests questions of fact which are non-existent.

Conceding the right to repair, plaintiff claims it sells no heads except with a filter cartridge. Assuming this to be the case, it does not present a dispute and does not take the sale out of the reach of an implied license. The limited warranty, extending beyond the life of the cartridge is likewise irrelevant and so also is the patent notice embossed on the units. The several claims are irrelevant absent a showing of publication of the patent to users. Further, they have no implication relevant to this issue. Plaintiff's cited authorities are not comparable to the facts in this case.

Summary

Plaintiff has not demonstrated any genuine issue of material fact on either of defendant's claims. As a matter of law, it is found that defendant's filter cartridge and adapter do not infringe on patent '171 inasmuch as it is a permissible repair and within an implied license authorized by plaintiff. These principles apply to plaintiff's filtration unit as covered by its combination patent. Absent direct infringement, there can be neither contributory nor induced infringement. Defendant is entitled to summary judgment as a matter of law.

Defendant's claims of patent misuse, inequitable conduct before the USPO and patent invalidity due to prior sales, and plaintiff's motion for preliminary injunction need not be decided.

Judgment shall enter for defendant.

B. Attorney Fees

Plaintiff has neither briefed nor argued defendant's claim for attorney fees. Notwithstanding Local Rule 9(b), it will not be presumed that plaintiff concedes the point. The failure, however, as providing no help to the court on the issue, can hardly be said to reflect a thoroughly professional approach.

Attorney fees are properly awarded in exceptional cases. 35 U.S.C. § 285. Bringing a case premised on untenable assertions of legal premises is a basis for such an award. A review of plaintiff's memorandum relative to the issues, discussed *supra*, reflects its paucity of authority supporting plaintiff's position and the imprecision in the way those cases have been analyzed. They all suggest the weakness of plaintiff's case, but weakness in itself does not mandate an award of fees. *Porter*, 790 F.2d at 886. Plaintiff's patent had a singular quality in that its purposes and uniqueness were formed in the coupling of the two units, the head and the cartridge. While this has been found to be the epitome of the combination patent, the assertion of the patent right is not found to have been so unsound as to have been frivolous. The combination patent, by definition, encompasses the cartridge. Plaintiff could have reasonably believed, therefore, that the cartridge was likewise patented separate and apart from the combination itself. It could also have reasonably believed that the combination of its filter head with defendant's adapter and cartridge *733 constituted a reconstruction of patent '171. Unfortunately, the law does not support this proposition. While plaintiff's claims were not carefully analyzed before suit was brought, the claim of patent protection is not deemed so far overreaching as to make this an exceptional case. As was noted in *Porter*, minds could differ on this point, but it is not the view here that plaintiff's claims are so illogical or unreasonable to warrant a fee award. See also *CTS Corp. v. Piher Int'l Corp.*, 727 F.2d 1550, 1558 (Fed.Cir.1984). Rather, they simply cannot be sustained in accordance with the law.

Moreover, it has not been clearly shown that reasonable inquiry was not made before suit was brought. Fed.R.Civ.P. 11. Though plaintiff's position has not been accepted, it cannot be said that it was totally devoid of merit. Fed.R.Civ.P. 11. See *Eastway Constr. Corp. v. City of New York*, 762 F.2d 243 (2d Cir.1985).

SO ORDERED.

JUDGMENT

This action having come on for consideration of the plaintiff's motion for preliminary injunction and the defendant's motion for summary judgment before the Honorable Peter C. Dorsey, United States District Judge, and

The Court having considered the full record of the case including applicable principles of law, and the Court having filed its Ruling on Motion for Preliminary Injunction and Motion for Summary Judgment, granting the motion for summary judgment in favor of the defendant,

It is accordingly ORDERED, ADJUDGED and DECreed that judgment be and is hereby entered in favor of the defendant.